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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/678,650	10/06/2003	Regine Hakenbeck	104049.B270037	7623

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EXAMINER
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WILDER, CYNTHIA B

ART UNIT	PAPER NUMBER
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1637

MAIL DATE	DELIVERY MODE
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08/09/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### **ATTACHMENT TO ADVISORY ACTION**

1. Applicant amendment after-final filed on 7/6/2010 is acknowledged and will be entered. However, the amendment does not place the claims 1, 24 and 26 in condition for allowance. The Examiner's response to Applicant's arguments appears below:

#### **Applicant's traversal**

2. Applicant traverses the rejection on the following grounds: Applicant states that the method of claims 1 and 24 comprises the step of hybridizing DNA from one species with probes for the same species, i.e., DNA sample of *S. pneumoniae* is hybridized with more than one probe for a sequence that is specific to a PBP gene of a penicillin sensitive to PBP gene of penicillin resistant *S. pneumoniae*. The claimed method allows a rapid, accurate discrimination between penicillin sensitive and penicillin resistant strains of *S. pneumoniae*. Applicant states that in contrast, Dowson et al disclose hybridizing DNA from one species to probes for a different species. Hence, Downson et al discloses hybridizing the DNA obtained from one species with probes specific for different species. Applicant states that their claimed method requires not only multiple probes that specifically hybridize to sequences that are specific to penicillin binding proteins, but also requires that the isolated DNA, as well as the probes hybridizing thereto, be from the same species, i.e., *S. pneumoniae*. Applicant asserts because Downson teaches comparing different species with one another et al cannot suggest any desirability of hybridizing a DNA with probes from the same species without resorting to hindsight reconstruction based upon Applicant's claimed invention.

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Applicant states that Kell does not overcome the deficiencies of Dowson et al and thus Kell's combination with Dowson et al fails to teach or suggest the invention as claimed.

### **Examiner's Response**

3. All of the arguments have been thoroughly reviewed and considered, but are not found persuasive for the reasons that follow: While the Examiner acknowledges Applicant's arguments, it is noted that contrary to Applicant's arguments, it is noted that Dowson et al disclose wherein the DNA obtained is hybridized to more than one DNA probe to a DNA sequence specific for a PBP gene of penicillin resistant strains of *Streptococcus pneumoniae* (Pn11, Pn13) and more than one DNA probe specific to a DNA sequence specific for a PBP gene of penicillin sensitive strains of *Streptococcus pneumoniae* (Pn12 and fragment from the PBP2B gene of the penicillin sensitive strain R6) (page 5859, second full paragraph, column 2). With regards to Applicant's arguments that Dowson teaches probes specific for different species, it is noted that the claims comprise the transitional term "comprising". MPEP 2111.03 states, "The transitional term 'comprising', which is synonymous with 'including,' 'containing,' or 'characterized by,' is inclusive or open-ended and does not exclude additional, unrecited elements or method steps." Therefore, the fact that the probes are capable of recognizing other strains is within the scope of the claims given the open-ended language. Applicant is reminded that the courts have established that during patent examination the pending claims must be interpreted as broadly as their terms

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reasonably allow (*In re Zletz*, 893 F.2d 321-22, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989)).

Finally in response to Applicant's arguments concerning the combination of cited prior art, the examiner maintains that the combination of Dowson et al in view of Kell meets the limitations of the claims as Kell supports the teachings of Dowson and further teaches hybridization method steps using probe(s) targeted to sequences specific for PBP genes in order to fingerprint penicillin resistant pneumococci (see abstract 4383 and 4384). The combination of Dowson in view of Kell clearly suggest that it is within the ordinary artisan technical grasp to screen a variety of sample for *Streptococcus pneumoniae* sensitivity or resistance using specific probes which target the PBP gene of penicillin resistance pneumococci when the sequences of the PBP gene are the same or different.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CYNTHIA B. WILDER whose telephone number is (571)272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/GARY BENZION/

Supervisory Patent Examiner, Art Unit 1637